

SEP 13 2004

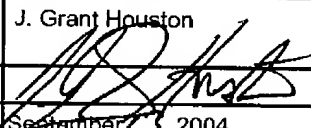
PTO/SB/21 (02-04)

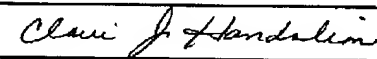
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/645,827	
	Filing Date	August 25, 2000	
	First Named Inventor	Dale C. Flanders	
	Art Unit	1725	
	Examiner Name	Johnson, Jonathan J.	
Total Number of Pages in This Submission	6	Attorney Docket Number	1000.0006

ENCLOSURES (Check all that apply)		
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re:	Dale C. Flanders	Confirmation No:	4350
Serial No:	09/645,827	Group:	1725
Filed:	August 25, 2000	Examiner:	Johnson, Jonathan J.
For:	Optical System Production System		
Customer No.:	25263		
Attorney Docket No.	1000.0006		

REPLY BRIEF UNDER RULE 1.93(b)(1)

VIA FACSIMILE: 703-872-9306

Mail Stop Appeal Brief- Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

This is a reply to the Examiner's Answer mailed July 14, 2004 in the above-captioned patent application, which is directed to new issues and arguments raised in the pending Examiner's Answer.

Answer's Assertion that "Attached" means "be in contact with"

The pending Examiner's Answer argues that the word "attached" means "to be in contact with." See Examiner's Answer at page 6, lines 13 and 14.

This argument is critical to the pending rejection.

The American Heritage® Dictionary, Fourth Edition, was cited for this definition.

It is Applicants' best information, however, that the American Heritage® Dictionary, Fourth Edition, does not contain this definition.

Application No.: 09/645,827
Amendment dated: September 13, 2004
Reply to Examiner's Answer dated July 14, 2004
Attorney Docket No.: 1000.0006

The following is the definition of "attach" and verb form "attached" from the American Heritage® Dictionary, Fourth Edition.

at·tach

v. at·tached, at·tach·ing, at·tach·es

v. tr.

1. To fasten, secure, or join: attached the wires to the post.
2. To connect as an adjunct or associated condition or part: Many major issues are attached to this legislation.
3. To affix or append; add: attached several riders to the document.
4. To ascribe or assign: attached no significance to the threat.
5. To bind by emotional ties, as of affection or loyalty: I am attached to my family.
6. To assign (personnel) to a military unit on a temporary basis.
7. Law. To seize (persons or property) by legal writ.

v. intr.

To adhere, belong, or relate: Very little prestige attaches to this position.
The American Heritage® Dictionary of the English Language, Fourth Edition
Copyright © 2000 by Houghton Mifflin Company.
Published by Houghton Mifflin Company.

Moreover, this definition is consistent with Applicants' use of the term "attached" and its variants in the present specification.

Most relevantly to the present issue is that American Heritage® Dictionary does not describe "attached" as "be in contact with."

Thus, the definition of the Answer appears to be an incorrect citation. Applicants' respectfully urge the board to reject the Answer's new definition of the word.

Answer concedes Wolfgang article fails to teach function of claim 17

On page 10, the Answer states:

While it is true that the adjusting system of Wolfgang *et al.* does not function in exactly the same way as the system of Appellants, the examiner finds that the two systems still meet the test for equivalence under 35 U.S.C. 112, 6th

Application No.: 09/645,827
Amendment dated: September 13, 2004
Reply to Examiner's Answer dated July 14, 2004
Attorney Docket No.: 1000.0006

paragraph they still function in substantially the same way. That is, it is the Examiner's position that merely because Applicants' system operates after the bonding step while Wolfgang, *et al.* system operates prior to and during the bonding step does not overcome the substantial similarities of the two systems function...

This concession seems directly relevant to the language of claim 17:

a pick-and-place machine for receiving optical benches from the bench supply, and for picking optical components from the optical component supply, and for attaching the optical components to the optical benches; and

means for characterizing the positions of the optical components attached to the optical benches, and for mechanically adjusting the relative positions of the optical components attached to the benches.

In short, claim 17 requires an alignment system that 'operates after bonding'.

Thus, the Answer's position seem untenable since *prima facie* equivalents requires that the prior art element must perform the identical function specified in the claim, yet it has been admitted that the function is not disclosed.

Answer concedes Wolfgang article fails to teach solder bonding

Claim 2 requires a "pick-and-place machine" that functions by solder bonding the components.

At page 11, first full paragraph, the Answer states that "Examiner agrees that Wolfgang, *et al.* does not explicitly recite solder bonding." Yet, anticipation is urged because the Wolfgang, *et al.* laser is hot enough to melt solder, see page 11 at lines 17-18.

It appears to the Applicants that the Examiner is advocating for an extension of anticipation when one could imagine how the prior art device could be modified or controlled to perform the functions of the claimed invention. This, however, is not the law.

Application No.: 09/645,827
Amendment dated: September 13, 2004
Reply to Examiner's Answer dated July 14, 2004
Attorney Docket No.: 1000.0006

Answer concedes Wolfgang article fails to teach flip chip bonder

In claim 7, the Applicants' have claimed the use of a specific type of machine, *i.e.*, flip-chip bonder.

The Answer concedes that the Article does not show a flip chip bonder. Yet, the Answer maintains the anticipation rejection. This position is justified in the Answer because it is "Examiner's position that the intended use of a flip-chip bonder does not result in a structural difference between the claimed invention and the prior art gripper of Wolfgang, *et al.* See page 12, line 17 of the Answer.

Applicants' admit to a certain degree of confusion. Earlier in the Answer, there was reticence to giving functional limitations much patentable weight. Now, there is a reticence to specific device limitations, *i.e.*, flip-chip bonder, being given patentable weight. Under the standards articulated in the Answer, it appears that anticipation occurs when one can imagine, apparently in hindsight, how a prior art device could be used in a fashion differently than that disclosed in the cited reference.

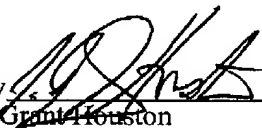
Conclusion

The pending Answer argues that the limitation "optical system aligner that characterizes positions of the optical components, which have been attached to the optical benches, and mechanically adjusts the relative positions of the optical components" of claim 1 should be given little patentable weight. Nonetheless, this position seems to concede that it be given some patentable weight, albeit little weight. Thus, even under this legal framework for anticipation, it seems that the threshold of non-anticipation has been met since, unless these limitations are entirely ignored, it is true the Wolfgang, *et al.* article does not show these claimed features.

Application No.: 09/645,827
Amendment dated: September 13, 2004
Reply to Examiner's Answer dated July 14, 2004
Attorney Docket No.: 1000.0006

Applicants believe that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

By 
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Billerica, Massachusetts 01821
Date: 9/13/04